

In the '852 patent, component (a) substantially corresponds to the applicants' component (i) and component (b) substantially corresponds to the applicants' claimed component (ii). The '852 patent states at col. 4, lines 39- 52:

“With respect to the polymer or polymer fraction (a) (hereinafter referred to as component (a)),

a number average molecular weight [measured by GPC (gel permeation chromatography) in terms of polyethylene, which is applied to the following] is less than 7,500, preferably 1,000 to less than 7,500, more preferably 2,000 to less than 7,500;

a weight average molecular weight is less than 15,000, preferably 1,000 to less than 15,000, more preferably 4,000 to less than 15,000;

an intrinsic viscosity (i.v., inherent viscosity at 135° C. when 1.0 g of the polymer is uniformly dissolved in 100 ml of decalin) is less than 0.25 dl/g; and

a glass transition point (T_g) is preferably less than 70° C.

With respect to the polymer or polymer fraction (b) (hereinafter referred to as component (b)),

a number average molecular weight is 7,500 or more, preferably 7,500 to 50,000;

a weight average molecular weight is 15,000 or more, preferably 15,000 to 500,000; and

an intrinsic viscosity (i.v.) is 0.25 dl/g or more.” (emphasis added).

Although this patent application has a filing date prior to the filing date of the '852 patent its clear that the components A and B would have to have the intrinsic viscosity measured at 135°C dissolved in the decalin.

Furthermore, enclosed in Appendix 3 is a search list that found 225 patents that issued between the years of 1991 and 1995 all that contain the terms “intrinsic viscosity” and “decalin.”

Enclosed in Appendix 3 is the list of the first 50 patents. The Examiner will note that most of the titles of these patents relate to polymers preferably of the olefin type polymer. Out of the first ten patents, only patent number five did not state that the intrinsic viscosity was measured at 135°C with decalin. Although it contained the word decalin it did not relate to the intrinsic viscosity. The applicants have enclosed the relevant pages from each of the other nine patents that cite the intrinsic viscosity in which each patent refers to intrinsic viscosity measured in decalin at 135°C. The values given in the applicants' specification can only be measured in decalin at 135°C.

With respect to the amendment to the claims, the applicants have amended the claims as suggested by the Examiner have been inserted the latest publication date (January 1987) of the DIN reference prior to the applicants' filing date. This was the revision in place when the applicants filed this application. It is clear that this revision would be one applicable unless the applicants stated that the earlier revision was applicable.

The disclosure was objected to because of informalities. Claims 17, 18, 19, 21, 22, 23, 24 and 25 are rejected under 35 U.S.C § 112, second paragraph. Claims 17, 18, 19, 21, 22, 23, 24 and 25 are rejected under 35 U.S.C § 112, first paragraph. Claim 16, 23, 24, and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese patent 2-184864 ("JP '964") combined with page 13 of Grant & Hackh's Chemical Dictionary 5th Edition ("Hackh's") and Diamond Handbook of Imaging Materials page 69 ("Diamond"). Claims 16, 21, 23, 26 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Masuda, U.S. patent 5,817,843 ("Masuda") combined with Inada, U.S. patent 5,741,617 ("Inada") and Minami, U.S. patent 5,179,171 ("Minami") as evidenced by Aldrich Catalog page 1063 ("Aldrich") and

Polymer Technology Dictionary page 487 ("Polymer"). The applicants respectfully traverse these rejections.

OBJECTION TO DISCLOSURE

The disclosure was objected to because of informalities. The Examiner stated that the intrinsic viscosity did not specify the solvent and the temperature. The intrinsic viscosity would be measured in decalin at 135°C for the reasons stated above.

At page 3, paragraph 2 of the Final Office Action, the Examiner stated that the specification does not define the standard DIN53461-B where the experimental conditions under which the HDT are determined. The Examiner also asserted that the specification does not disclose the date of the particular version of the standard that was used. The applicants have incorporated the experimental data section from DIN 53461. The appropriate revision of the DIN 53461 would be the one that was currently in use at the time of the filing of the application (revised January 1987). If the applicants would have wanted the earlier 1969 revision, the specification would have stated that. For the above reasons the applicants believe the specification is enabled and that the amendment to the specification adds no new matter. For the above reasons this objection should be withdrawn.

§ 112 SECOND PARAGRAPH REJECTION

Claims 17, 18, 19, 21, 22, 23, 24 and 25 were rejected under 35 U.S.C. § 112 second paragraph. With respect to intrinsic viscosity, the applicants believe that it is clear that it is determined that in decalin at 135°C for the reasons stated above. Furthermore, U.S. patent 6,210,852 which shows the same polymer defines that the intrinsic viscosity is measured at 135°C in decalin. This is inherent in the examples in the applicants' specification. The

applicants have incorporated the terms of DIN 53461-B into their specification. Therefore, the rejection based on HDT should be withdrawn.

Claim 19 was amended to make it clear that the low viscosity resin has a M_w/M_n ratio of 1 to 2.5 as the Examiner has suggested.

Claim 22 has been amended so that the polyolefin resin with the cyclic structure is present in an amount of not more than 50% by weight. Although it was previously argued that the claim included 0% in the previous amendment, the Examiner was correct that the previous claim included 0%. However, in this amendment the polyolefin resin with cyclic structure is required to be present in an amount not to exceed 50%. Therefore, this claim further limits the claims 17 and 18.

For the above reasons the applicants believe that the claims are in compliance with 35 U.S.C. § 112 second paragraph and respectfully request that this rejection be withdrawn.

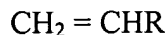
§ 112 FIRST PARAGRAPH REJECTION

Claims 17, 18, 19 and 21 through 25 were rejected under 35 U.S.C. § 112 first paragraph. The applicants believe that the claims as amended in view of the amendment to the specification are in compliance with 35 U.S.C. § 112 first paragraph. For the above reasons this objection should be withdrawn.

103 REJECTION OF JP '864

Claims 16, 23, 24, and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over JP '864 in view of Hackh's and Diamond. The applicants believe that JP '864 does not disclose alpha olefins as required by the applicants claimed invention. The Examiner points out that JP '864 discloses a methacrylic acid and asserts that it is an alpha olefin acid. An alpha olefin is defined as having a double bond between the first and second carbon atom. Appendix 4

lists several patents that defines alpha olefins. The one position is indicated as having the double bond. Alpha olefins are a term recognized by one of ordinary skill in the olefin art. The Examiner stated that the applicants haven't defined the term alpha olefin, however, again this is a well recognized term in the art. Alpha olefins have the following formula:



wherein R is hydrogen or alkyl.

For example, the following are alpha-olefins (α -olefins)-

$\text{CH}_2=\text{CH}_2$ - ethylene

$\text{CH}_2=\text{CHCH}_3$ - propylene

$\text{CH}_2=\text{CHCH}_2\text{CH}_3$ - 1-butylene

$\text{CH}_2=\text{CHCH}_2\text{CH}_2\text{CH}_3$ - 1-pentene

As previously stated JP '864 does not disclose the alpha olefins as is claimed by the applicants. The applicants do not believe that the secondary references cure the deficiency of the primary reference for the above reasons this rejection should be withdrawn.

REJECTION OVER MASUDA

Claims 16, 21, 23, 26 and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Masuda combined with Inaba, and Minami as evidenced by Aldrich and Polymer. Masuda does not recognize the advantage of the applicants' claimed binder resin. Masuda discloses that any binder resin known in the art to be used, however, the applicants have found that using their specific binder resin has exhibited unexpected properties. There would be no reason for one to selectively pick and choose the applicants claimed invention.

The Examiner must consider the references as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters without any direction as to the particular one selection of the reference without proper motivation. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious unless desirability of such modification is suggested by the prior art (In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2nd. 1780 (Fed. Cir. 1992)). The applicants disagree with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting this combination, although it may have been obvious to try various combinations of teachings of the prior art references to achieve the applicant's claimed invention, such evidence does not establish prima facie case of obviousness (In re Geiger, 2 USPQ 2d. 1276 (Fed. Cir. 1987)). There would be no reason for one skilled in the art to combine Masuda combined with Inaba, and Minami as evidenced by Aldrich and Polymer. For the above reasons, this rejection should be withdrawn.

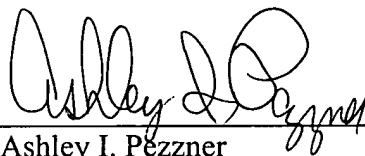
The applicants have enclosed the form 1449 listing the references cited in the search report that the Examiner referred to at page 30, paragraph no. 12 of the Office Action.

A one month extension fee has been paid. If there are any additional fees due in connection with the filing of this response, including any fees required for an additional extension of time under 37 CFR 1.136, such an extension is requested and the Commissioner is authorized to charge any debit or credit any overpayment to Deposit Account No. 03-2775.

For the reasons set forth above, Applicants believe that the claims are patentable over the references cited and applied by the Examiner and a prompt and favorable action is solicited. The applicants believe that these claims are in condition for allowance, however, if the Examiner disagrees, the applicants respectfully request that the Examiner telephone the undersigned at (302) 888-6270.

Respectfully submitted,

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AIP/cmd

Enclosures: Appendix 1
Appendix 2
Appendix 3
Appendix 4
Form 1449

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